REMARKS

The above-identified application was allowed in the Notice of Allowance mailed October 14, 2005, which also included an Examiner's Amendment to the allowed claims. Because of inconsistencies between the allowable subject matter identified in the Examiner's Amendment and in previous Office Actions, Applicants paid the issue fee concurrently with filing a Rule 312 amendment to clarify these inconsistencies. The Office issued a Response to the Rule 312 Communication on March 15, 2006, in which the Rule 312 Amendment was disapproved. Accordingly, in response to the Office's Rule 312 Communication, Applicants submit herewith a Petition to Withdraw from Issue under 37 C.F.R. § 1.313(c)(2) and RCE under 37 C.F.R. § 1.114 along with the present Amendment for consideration by the Examiner. This paper corrects the noted inconsistency with the Examiner's Amendment detailed below, but does not cancel claims 38, 44, 73 or 79 and does not cancel the species of aldehydes, quinones, diiminoioindoline derivatives, and 3-aminoisoindolone derivatives, which were canceled by the Examiner's Amendment, and further clarifies the issues surrounding the subject matter encompassed by these claims.

With this amendment, claims 17-20, 26-29, 38, 39, 42, 44-53, 56, 57, 61-64, 70, 73, 74, 77, and 79-100 are pending and claims 21-25, 30-37, 40, 41, 43, 54, 55, 58-60, 65-69, 71, 72, 75, 76, and 78 are canceled. Claims 17, 49 and 98 are amended. The amendments to the claims are fully supported by the specification and correspond, in part, with the Examiner's Amendment dated October 14, 2005. Accordingly, no new matter is added by these amendments.

After the receipt of the Notice of Allowance, Applicants identified a number of inconsistencies between the allowable subject matter identified in the Examiner's

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Amendment and the subject matter indicated as allowable in the previous Office Actions. For example, on page 3, ll. 6-9; page 4, ll. 12-14, and page 5, ll. 16-18 of the Examiner's Amendment, the Office canceled subject matter directed to aldehydes, quinones, diiminoioIndoline derivatives, and 3-aminoisoindolone in independent claims 17, 49, and 98. In the Office Action dated May 26, 2005, at page 2, under "Allowable Subject Matter," this subject matter was identified as allowable.

Although Applicant initially elected compound of formula (VIII) from (A) and ketones from (B), the Office stated in the Office Action dated April 5, 2004, at page 5, ll. 13-16 that "[s]ince no prior art be[sic] found to anticipate or render obvious the elected species, [t]he examiner has **extended** the search of the Markush-type claim with respect to a nonelected species, and accordingly, claims 21-25, 30-37, 40-41, 54-55, 58-60, 64-72, 75-76 and 78 are withdrawn from further consideration." Furthermore, in the Office Action dated May 26, 2005, at page 2, line 19- page 3, line 3, the Office expressly stated that "claims 17-20, 28-29, 38-39, 42, 44-53, 56-57, 63-64, 73-74 and 79-100 are allowable because the prior art of record do not teach or disclose a dyeing composition comprising . . . at least one compound chosen from *aldehydes, ketones, quinones, diiminoioindoline derivatives, and 3-aminoisoindolone derivatives.*" Office Action dated May 26, 2005, at page 2 (emphasis added). Moreover, Applicants relied on this statement by the Examiner. As such, with the present amendment submitted herein, Applicants have not deleted the species of aldehydes, quinones, diiminoioindoline derivatives, and 3-aminoisoindolone derivatives.

Accordingly, Applicants respectfully request clarification as the scope of the extended search and reconciliation with the Examiner's statement in the Office Action dated May 26, 2005.

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Further inconsistencies can be found by comparing the allowable claims identified in the Office Action dated May 26, 2005, to the allowable claims identified in the Examiner's Amendment dated October 14, 2005. The chart and discussion below summarize these inconsistencies.

	ALLOWABLE CLAIMS									
Office Action dated 5.26.2005	17-20	28-29	38-39	42	44-53	56-57	63-64	73-74		79-100
Examiner's Amendment dated 10.14.2005	17-20	26-29	39	42	45-53	56-57	61-64	74	77	80-100

Claims 38 and 73 are directed to aldehyde derivatives of formula (XVII). Applicants' Specification at pages 13-15. In the Office Action dated May 26, 2005, the Office indicated that these claims contained allowable subject matter. In fact, from the Examiner's expanded search, the Examiner stated on the record that at least claims 38 and 73 were now under consideration and even, rejected claims 38 and 73 under 35 U.S.C. § 103(a) as unpatentable over Wenke. Office Action dated April 5, 2004, at pages 5 and 6. Moreover, Applicants specifically asked for clarification regarding these claims in the Response filed August 5, 2004, to which the Examiner replied in the Office Action dated November 11, 2004 at pages 3 and 4 that claims 38 and 73 were the subject of a rejection. In the Office Action dated May 26, 2005, the Examiner stated that these claims contained allowable subject matter and Applicants relied on this indication. Despite this, the Examiner's Amendment canceled these claims. Notice of Allowability dated October 15, 2005.

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Given this disparity, Applicants respectfully request an explanation for the cancellation of these claims by the Examiner. These claims are clearly not directed to non-elected species because they were the subject of a rejection after Applicants' election and after the Examiner expanded the search, and later, deemed to contain allowable subject matter by the Examiner. Applicants submit that the cancellation of claims 38 and 73 was an error and should be corrected.

Claims 44 and 79 recite at least one derivative chosen from aldehydes, ketones, quinones, diiminoisoindoline and 3-aminoisoindolone. Specification at page 20. Claims 44 and 79, like claims 38 and 73, were not withdrawn from consideration by the Examiner in the Office Action dated April 5, 2004, and in fact, were also the subject of a Section 103(a) rejection as unpatentable over Wenke. Office Action dated April 5, 2004, at pages 5 and 6. The Examiner even reiterated the rejection of these claims in the Office Action dated November 3, 2004, when Applicants asked for clarification regarding the expanded search. In addition, in the Office Action dated May 26, 2005, the Examiner indicated that these claims contained allowable subject matter. Claims 44 and 79, however, were canceled by the Examiner's Amendment dated October 14, 2005.

Again, given this disparity, Applicants respectfully request an explanation for the cancellation of claims 44 and 79 by the Examiner. These claims, like claims 38 and 73, are clearly not directed to non-elected species, but instead, have been twice the subject of a rejection (after the initial election requirement and after the examiner expanded the search) and later, deemed to contain allowable subject matter by the Examiner. Applicants submit that the cancellation of claims 44 and 79 was an error and should be corrected.

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With respect to **claim 17**, Applicants indicated in the Rule 312 Amendment that Examiner's direction on page 2, line 17 of the Examiner's Amendment, which states that "[i]n claim 17, in page 7, delete line 7 under the formula (VIII)" is confusing because line 7 is immediately under formula (VIII) and formula (VIII) was not canceled. In the Response to the Rule 312 Communication, the Examiner indicates that line 7 states "derivatives having formula (IX) and derivatives having formula (X)" and that Applicants confirm this in the Rule 312 Amendment. This, however, is not true.

As stated in Applicants Rule 312 Amendment, line 7 encompasses the recitation directed to pyridine derivatives having formula (VIII). Applicants maintain that the Office's instruction should have been to delete the **last line** on page 7, i.e., "8) derivative having formula (IX) and derivatives having formula (X):". This instruction to amend claim 17 corresponds to similar subject matter canceled in the other independent claims, *e.g.*, the Office's instruction on page 4, lines 2 and 3, and page 5, lines 5 and 6. Accordingly, Applicants have made this change in claim 17 in the presently filed amendments.

Based on these inconsistencies found in the Examiner's Amendment dated October 14, 2005, and the disapproval of the Rule 312 Amendment dated March 15, 2006, Applicants hereby re-open prosecution by filing a Petition to Withdraw from Issue under 37 C.F.R. § 1.313(c)(2) and RCE under 37 C.F.R. § 1.114 to clarify the allowable subject matter to ensure proper amendments to the claims and to clarify subject matter to be pursued in a divisional application.

Provided below is the a summary of relief Applicants seek with respect to the claims at issue:

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1. Deleted species - Clarification on the record as to why aldehydes, quinones, diiminoioindoline derivatives, and 3-aminoisoindolone derivatives were canceled, when the examiner extended the search of the Markush-type claim, in the Office Action dated April 5, 2004, page 5, ll. 13-16.

2. Claims 38 and 73 - Allowance of these claims based on the Examiner's statement in Office Action dated May 26, 2005 at page 2, especially considering these claims were the subject of a rejection.

3. Claims 44 and 79 - Allowance of these claims based on the Examiner's statement in Office Action dated May 26, 2005 at page 2, especially considering these claims were the subject of a rejection.

4. Claim 17 - Amendments to this claim regarding formula (VIII) are included with the amendments presented herein.

In view of the foregoing amendments and remarks, Applicants respectfully requests reconsideration of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER, L.L.P.

Dated: April 18, 2006

By: _____
Adriana L. Burgy
Reg. No. 48,564

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